

REMARKS

Claims 1, 3-4 and 6-26 are pending in the current application. Claims 1, 4, 14 and 15 are independent claims. Claims 2 and 5 are cancelled by this Amendment.

Entry of Amendments Requested Pursuant to 37 CFR § 41.50(b)(1) and MPEP §

1214.01

On March 8, 2007, the USPTO Board of Patent Appeals and Interferences reversed the Examiner's art grounds of rejection of claims 1-26. However, the Board of Appeals entered a new art grounds of rejection in accordance with 37 CFR § 41.50(b) (see pages 6-9 of the Appeal Decision).

MPEP § 1214.01 recites the following:

1214.01 Procedure Following New Ground of Rejection by Board [R-3]

When the Board makes a new rejection under **37 CFR *>41.50(b)<**, the appellant, as to each claim so rejected, has the option of:

(A) >reopening prosecution before the examiner by< submitting an appropriate amendment and/or ****>new evidence (37 CFR 41.50(b)(1))<**;

I. SUBMISSION OF AMENDMENT OR **>NEW EVIDENCE<****

37 CFR ***>41.50(b)(1)<** provides that the application will be remanded to the examiner for reconsideration if the appellant submits "an appropriate amendment" of the claims rejected by the Board

Accordingly, consistent with the provisions of MPEP § 1214.01, Applicant respectfully requests entry of all present amendments.

Allowable Subject Matter

As described above, the Board of Appeal has reversed the previous art grounds of rejection under 35 U.S.C. §103(a) as being unpatentable over Chen and Moskowitz, and has issues a new art grounds of rejection under 35 U.S.C. § 102(e) based on Thrift. The new art ground of rejection rejects claims 1-8, 14, 15, 17 and 24-26.

Accordingly, as the Board of Appeals has opted not to reject claims 9-13, 16 and/or 18-23, Applicant respectfully requests that the Examiner indicate that these claims would be allowable if rewritten into independent form.

Further, in view of the present amendments and the remarks below, Applicant respectfully submits that all claims are allowable in their present form.

35 U.S.C. § 102(e) –Thrift

Claims 1-8, 14, 15, 17 and 24-26 stand rejection under 35 U.S.C. § 102(e) as being anticipated by Thrift. Applicant respectfully traverses this art grounds of rejection.

Thrift is directed to an apparatus for the integration of television signals and information from an information service provider. In particular, referring to Figure 1 of Thrift, Thrift discloses a java television receiver 10 (e.g., a set top box) which is installed in a subscriber's home in proximity to a display device, such as a television 40 (See column 2, lines 36-54 of Thrift). The java television receiver 10 is configured to receive both a TV signal (e.g., from a cable station or a local video device) as well as internet via internet connection 14 (see column 2, lines 43-47 of Thrift).

The java television receiver 10 includes a vertical blanking interval (VBI) decoder 28. Thrift states that the "VBI decoder 28 removes any information from the vertical blanking interval such as closed-captioning information and Teletext text" (see column 3, lines 11-15 of Thrift). Thrift further states that "information concerning the URL or other internet information can be sent by the television channel signal in the vertical blanking interval.

That information can be decoded by VBI decoder 28 and sent to JTVP 12 where JTVP 12 can then access that URL via internet connection 14” (see column 3, line 35-40).

Accordingly, a java television receiver 10 may extract a web address from the VBI decoder 28, and may retrieve the designated website via the internet connection 14. Thus, it will be appreciated that the functionality of providing a web address via a television signal and retrieving the web address is dependent upon an integrated device including both an interactive internet connection as well as a broadcasted television input signal.

Applicant directs the Examiner to the presently amended versions of each of the independent claims. The currently pending independent claims have been clarified to recite that the decoding of the watermark is performed “at a central location not in physical proximity to a principal program presentation device for said one or more subscribers.”

In the Appeal Decision, the Board of Appeal stated that “[t]he receiving and decoding apparatus in Thrift can be considered at a ‘central location,’ as recited in claims 3 and 6, because the “central location” is not defined, and the apparatus can be central to a subscribers home” (see page 7 of the Appeal Decision). However, by the present wording of the amendments to each of the independent claims, Applicant respectfully submits that the “central location” has been clarified as being separate from a principal program presentation device of the subscriber (i.e., “not in physical proximity to a principal program presentation device for said one or more subscribers”). Applicant further points out that claims 9-12, which have been implicitly indicated as allowable by the Appeal’s Board, also clarify that the central location is not in physical proximity to a principal program presentation device for said one or more subscribers, and as such the Appeal’s Board appears to recognize this particular deficiency of Thrift.

Further, it would simply be impractical to modify the teachings of Thrift for implementation at a location other than near (e.g., connected to) a principal program presentation device of the subscriber. The java television receiver 10 is a set top box which is

configured to receive a local video input signal (e.g., from VCR 20 of Figure 1, or a cable broadcast signal routed through VCR 20) and also to receive internet via internet connection 14. It would be impractical to outsource a device combining these features to another location, such as a cable re-broadcasting location. For example, if the cable set top box of Thrift were outsourced in this manner, the resultant signal entering a subscriber's home would no longer have internet connectivity (e.g., because the output of java television receiver 10 is simply an audio and video combination signal output to the television). The subscribers would then still require a separate internet connection to actually achieve any interactivity with regard to the website and the input video signal because internet access is achieved through internet connection 14, and not the java television receiver 10 (e.g., which is merely a display device and is not interactive in and of itself). Accordingly, in the context of Thrift, the java television receiver 10 is clearly intended only to be used in an individual subscriber's home, and outputs directly to the subscriber's television.

Accordingly, Applicant respectfully submits that Thrift cannot disclose or suggest "decoding, , at a central location not in physical proximity to a principal program presentation device for said one or more subscribers, said embedded watermark ..." and/or "second transmitting ... said specific data ... from the central location to said one or more subscribers" as recited in independent claim 1 and similarly recited in each of independent claims 4, 14 and 15.

In view of the above remarks, Applicant respectfully submits that each of claims 1, 4, 14 and 15 are allowable.

As such, claims 3, 6-8, 17 and 24-26, dependent upon independent claims 1, 4, 14 and 15, respectfully, are likewise allowable over Thrift for at least the reason given above with respect to independent claims 1, 4, 14 and 15.

Applicant respectfully requests that the Examiner withdraw this art grounds of rejection.

Reconsideration and issuance of the present application is respectfully requested.

CONCLUSION

Accordingly, in view of the above amendments and remarks, reconsideration of the objections and rejections and allowance of each of claims 1, 3-4 and 6-30 in connection with the present application is earnestly solicited.

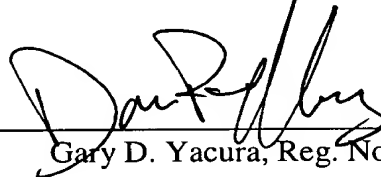
Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Gary D. Yacura at the telephone number of the undersigned below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

HARNESS, DICKEY, & PIERCE, P.L.C.

By



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